UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/057,197	10/26/2001	Martin J. Wensley	00014.01R	1701

37485 7590 10/24/2008

SWANSON & BRATSCHUN, L.L.C
8210 SOUTHPARK TERRACE
LITTLETON, CO 80120

EXAMINER	
EREZO, DARWIN P	
ART UNIT	PAPER NUMBER
3773	

MAIL DATE	DELIVERY MODE
10/24/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/057,197	WENSLEY ET AL.	
	Examiner	Art Unit	
	Darwin P. Erezo	3773	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *25 July 2008*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *48,124-130,184-191,198,199 and 204-229* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *48,124-130,184-191,198,199 and 204-229* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *See Continuation Sheet*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :12/23/02,1/21/03,5/12/03,2/20/04,9/13/06,11/22/06,12/5/07,1/17/08,/3/21/08.

DETAILED ACTION

1. The applicant's amendment filed on 7/25/08 has been entered in the application. Claims 48, 124-130, 184-191, 198, 199, 204-229 are currently pending.

Response to Arguments

2. With regards to the claims rejected under 35 USC 112, 2nd paragraph in the Office action mailed on 2/25/08, the applicant has cancelled the claims to render the rejection moot.

3. With regards to the claims rejected under provisional obviousness-type double patenting, the applicant noted that application used in the rejection, 10/696,959, has now been abandoned. The rejection is now withdrawn.

4. However, upon further review of the prosecution history of the abandoned application 10/696,959, the examiner is now implementing a similar non-provisional and provisional obviousness type double patenting rejection.

Double Patenting

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to

be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 48, 124-130, 184-191, 198,199, 204-229 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over the claims listed below for each patent.

PATENT	CLAIMS	Heating step	Aerosol Size	Metal Substrate
6716415	1-5, 7	X	X	X
6716416	7-13	X	X	X
6716417	6-12	X	X	X
6737042	9-20	X	X	X
6737043	5-10	X	X	X
6740307	6-14	X	X	X
6740308	8-16	X	X	X
6740309	5-11	X	X	X
6743415	5-10	X	X	X
6759029	7-14	X	X	X
6776978	24-28	X	X	X
6780399	6-12, 14	X	X	X
6780400	7-14	X	X	X
6783753	6-13	X	X	X

6803031	7-13	X	X	X
6805853	7-15	X	X	X
6805854	5-10	X	X	X
6814954	8-16	X	X	X
6814955	3-5	X	X	X
6855310	6-12	X	X	X
6884408	5-9	X	X	X
6994843	4-26	X	X	X
7005121	1-6,15-22	X	X	X
7005122	4-6	X	X	
7008615	1-11, 20-26	X	X	X
7008616	1-8	X	X	X
7011819	1-6	X	X	
7011820	1-11, 20-27	X	X	X
7014840	1-6	X	X	
7014841	1-9, 18-22	X	X	X
7018619	1-10, 21-26	X	X	X
7018620	1-11, 21-28	X	X	X
7018621	4, 5	X	X	
7022312	4-6, 16-24, 28, 29	X	X	X
7029658	1-27	X	X	X

7033575	4-6, 24-40	X	X	X
7045118	5-20, 26-30	X	X	X
7045119	1-7, 16-18	X	X	X
7048909	4-6, 18-28, 34-38	X	X	X
7052679	4-6, 26-44, 58-70	X	X	X
7052680	5-7, 24-40	X	X	X
7060254	4-6, 34-60, 82-102	X	X	X
7060255	4-6, 18-28, 33-35	X	X	X
7063830	5-7, 18-28, 34-38	X	X	X
7063831	4-6, 16-24, 28-30	X	X	X
7063832	1-10, 19-24	X	X	X
7067114	4-6, 23-38, 49-58	X	X	X
7070761	1-9, 18-31	X	X	X
7070762	1-9, 18-22	X	X	X
7070763	5-8, 19-23	X	X	X
7070764	4-6, 16-24, 28-30	X	X	X
7070765	7-12, 25-36	X	X	X
7070766	1-13, 22-30	X	X	X
7078016	8-14	X	X	X
7078017	1-6, 15-23	X	X	X
7078018	1-14, 23-34	X	X	X

7078019	1-6, 15-24	X	X	X
7078020	1-19, 28-42	X	X	X
7087216	4-6, 17-26, 30-32	X	X	X
7087217	4-6, 25-42, 55-66	X	X	X
7087218	5-8, 15-20, 22	X	X	X
7090830	1-48 (composition made from the methodology)	X	X	X
7094392	1-16, 25-36	X	X	X
7108847	4-6, 17-26, 31-34	X	X	X
7115250	1-9, 18-22	X	X	X
7169378	4-6, 24-40, 52-62	X	X	X
7442368	7-30	X	X	

Although the conflicting claims are not identical, they are not patentably distinct from each other because the method steps recited in the application are also recited in the claims of the patent.

For example, the independent claims in the application recite the steps of heating a compound to form a compound and mixing the vapor with a gas. These steps are recited in the patent, as listed in the table above. Note that mixing the vapor with a gas is viewed as the cooling step, which would be inherent. Furthermore, the claims in the patent also recite the aerosol having a specific MMAD. This is viewed as particles having a desired size range, which is viewed as a sufficiently stable. As to the step of

using a mesh screen, it is noted that majority of the claims in the patents above recite the use of a metal substrate. Therefore, substituting the metal substrate with a mesh screen (having a specific mesh size) would be a mere obvious design choice to one of ordinary skill in the art. It would also be obvious to use a capacitor as the energy source since capacitors are a well known energy/current source.

7. Claims 48, 124-130, 184-191, 198,199, 204-229 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over the claims listed below for each application

Application Number	Claims
10146088	1-6, 12-16, 19-24, 31-36, 38-61
10437643	47-58, 71-82
10633876	12-19
10633877	15-19
11398383	10-24, 28-38
11370628	7-18, 21-30
11442917	20-40, 46-58
11451852	17-31, 39-43, 45, 47-49
11451853	64-181
11454573	16-36, 42-54
11479361	6, 8, 9, 13-23, 25-28
11479509	34-48, 52-54, 58-60, 64-72, 81-96
11479892	10-38

11481279	10-38
11488302	9-11, 16-18, 22-29
11500736	5-7, 9-11, 16-22
11501246	34-69, 73-78, 94-113
11507986	62-97, 108-124
11670892	20-24

Although the conflicting claims are not identical, they are not patentably distinct from each other because the method steps recited in the application are also recited in the claims of the copending applications

For example, the independent claims in the application recite the steps of heating a compound to form a compound and mixing the vapor with a gas. These steps are recited in the claims of the copending applications. Note that mixing the vapor with a gas is viewed as the cooling step, which would be inherent. Furthermore, the claims in the copending applications also recite the aerosol having a specific MMAD. This is viewed as particles having a desired size range, which is viewed as a sufficiently stable. As to the step of using a mesh screen, it is noted that majority of the claims in the copending applications recite the use of a metal substrate. Therefore, substituting the metal substrate with a mesh screen (having a specific mesh size) would be a mere obvious design choice to one of ordinary skill in the art. It would also be obvious to use a capacitor as the energy source since capacitors are a well known energy/current source.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Darwin P. Erezo whose telephone number is (571)272-4695. The examiner can normally be reached on M-F (8:00-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jackie Ho can be reached on (571) 272-4696. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Darwin P. Erezo/
Primary Examiner, Art Unit 3773